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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,693	06/25/2001	Oleg Serebrennikov	3479/OH737	7209

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EXAMINER

STEVENS, ROBERT

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/810,693	SEREBRENNIKOV, OLEG
	Examiner Robert M Stevens	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 June 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/14/2001</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. Claims 1-28 are pending in Application No. 09/810,693, entitled "Method and Apparatus for the Dynamic Modification of Relational Information in Electronic Documents such as HTML Pages and the Like", filed June 25, 2001, claiming benefit by virtue of foreign (Russian Federation) applications numbered 2000108556 (filed 7/4/2000) and 2000111714 (filed 12/5/2000). Claims 1, 13, 17, 23, 24 and 27 are independent.
2. The Office acknowledges IDS filed on May 14, 2001.
3. Acknowledgement is made of a claim for foreign priority under 35 USC 119 (a)-(d), however the Office notes that English translations of these Russian Federation applications have yet to be filed. Therefore, the requisite conditions for 35 USC 119 (a)-(d) have not been met as of the date of this Communication.

***Drawings***

4. The drawings are objected to because:
  - a. The drawings are informal.
  - b. The figures contain illegible reference numerals and labels.
  - c. The following reference numbers are missing: Fig. 1 (100, 110), Fig. 2 (210, 220, 230), Fig. 4 (460, 470).
  - d. The following reference numbers appear in the Figures, but are not addressed in the specification: Fig. 1 (102, 104, 106).

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5. Applicant is reminded to also refer to the enclosed form PTO-948, "Notice of Draftsperson's Patent Drawing Review".

***Specification***

6. The Abstract contains redundant wording ("code" is duplicated) in line 6.  
Please correct all spelling/grammatical/etc. errors throughout the specification.
7. The disclosure is objected to because of the following informalities:
  - a. Please correct all spelling/grammatical/etc. errors throughout the specification (including the Abstract), such as the redundant word "code" in line 6 of the Abstract and the misspelled word "spirit" of page 12 line 6;
  - b. Page 9 line 22: the word "phrase" seems to be defined as " a group of synonyms" [i e., a multiplicity of related words]. Is this what was intended?
  - c. Page 23 lines 17-25 indicate that an Option Manager Dialog Box is updated with invalid names (please explain).

Appropriate correction is required.
8. All non-patent literature relied upon for background information and cited throughout the specification (an example is found on page 2 line 32 continuing onto page 3 line 1) needs to be submitted via an IDS or as an appendix to the specification.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 1-12, 14, 22-23 and 27-28 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**Regarding claim 1**, there was no enablement as to how a “phrase” is determined taught within the specification (i.e., how the invention determines that a string of more than one word is to be parsed from the original document rather than stopping at one word).

**Claims 2-12** are dependent upon claim 1, and therefore are likewise rejected.

**Additionally, in regards to claim 6**, there was no enablement within the specification as to how the system is to be designed to operate on a handheld computing device, given the system resource constraints (such as memory) commonly associated with such devices.

**Additionally, in regards to claim 7**, there was no enablement (i.e., implementation detail) within the specification for “intercepting, comparing and re-marking steps are performed by utilizing a user’s web browser plug-in functionality”.

**Additionally, in regards to claim 9,** there was no enablement within the specification as to how a user “selectably determines the subject matter for comparing”.

**Additionally, in regards to claim 11,** there was no enablement within the specification as to how a user “selectably activates and deactivates said intercepting, comparing and re-marking steps”.

**In regards to claim 14,** there was no enablement within the specification as to how a user would operate with a first set of information being graphical, audio or video data (especially how the system would search a database to associate hyperlinks to such data/information).

**Regarding claim 22,** there was no enablement within the specification as to how “charging” is performed by a computer system.

**Regarding independent system claim 23,** there was no enablement within the specification as to how a “phrase” is determined (i.e, how the invention determines that a string of more than one word is to be parsed from the original document rather than stopping at one word).

**Regarding independent method claim 27,** there was no enablement as to how a “phrase” is determined taught within the specification (i.e, how the invention determines that a string of more than one word is to be parsed from the original document rather than stopping at one word).

**Claim 28** is dependent upon claim 27, and therefore is likewise rejected.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. **Claims 14 and 17-22 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claim 14**, the claim is vague and indefinite because one cannot determine whether “said information” refers to a first, second or modified first information.

**Regarding claim 17**, the claim is vague and indefinite. The phrase “said first set of information” in lines 4-5 seems to refer back to the preamble. However, the preamble refers to a “first set of information to be transmitted ...to a user”. Note that the “first set of information” in lines 4-5 has been transmitted from a user.

**Claims 18-22** are dependent upon claim 17, and therefore are likewise rejected.

**Also regarding claim 18**, the claim is vague and indefinite because one cannot reliably determine whether “said file” refers to the first file mentioned in the preamble or to the modified file of the last limitation of the claim.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. **Claims 1-5, 8-10, 13-16 and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Niemi (US Patent No. 6,415,294, filed Feb. 16, 1999 and granted Jul. 2, 2002, hereafter referred to as "Niemi").**

**Regarding independent method claim 1, Niemi discloses:**

A method for automatically converting one or more phrases in a hypertext-enabled document to one or more respective hyperlinks comprising the steps of:

*intercepting said hypertext-enabled document prior to being displayed to a user; (col. 4 lines 10-13, noting "the page is intercepted") comparing each of said phrases in the hypertext-enabled document to a database containing a list of words and associated hyperlink information for a match; (col. 4 lines 21-24, discussing a first word table, and col. 4 lines 53-57 discussing a second table comprising the number of occurrences of each word and a corresponding document/URL)*

*re-marking the hypertext-enabled document to include associated hyperlink information in accordance with each said match; (col. 5 lines 10-17, noting "added hyperlinks") and*

*displaying the re-marked hypertext-enabled document to said user. (col. 4 lines 13-16, stating "Before forwarding the page to the ... browser for display, the page is modified....")*

**Regarding claim 2**, which is dependent upon claim 1, Niemi discloses:

*wherein the phrase comprises one or more words.* (col. 4 lines 20-29, discussing a word table and a stemming algorithm)

**Regarding claim 3**, which is dependent upon claim 1, Niemi discloses:

*further including the step of applying the one or more phrases to a morphology database before the comparing step, wherein said comparing step operates upon both the one or more phrases and the respective resulting morphs from the applying step.* (col. 4 lines 20-29 discussing a word table that lists word stems [i.e., a morphology database] and a stemming algorithm and col. 4 lines 53-57 discussing the document table, comprised of word occurrences and associated URLs)

**Regarding claim 4**, which is dependent upon claim 3, Niemi discloses:

*wherein the morphology database outputs inflections* (col. 4 lines 23-25 “produced” is an inflection or tense morph, as per the page 10 lines 10-11 specification definition) *and derivations of an inputted phrase.* (col. 4 lines 23-25 “producing” is a derivation morph, as per the page 10 lines 11-12 specification definition)

**Regarding claim 5**, which is dependent upon claim 1, Niemi discloses:

*wherein the steps of intercepting, comparing and re-marking are performed by a user's computer system.* (col. 3 lines 65 continuing to col. 4 line 1, discussing the embodiment illustrated in Fig. 1 in which the invention appears functionally between the user's browser software and modem and “may be implemented by ... programming the cpu of the PC”)

**Regarding claim 8**, which is dependent upon claim 1, Niemi discloses:

*wherein said database is sortable by subject matter.* (col. 7 lines 45-50, discussing determining web page association via “other than conventional keywords”, such as names, dates, tasks or combinations thereof)

**Regarding claim 9**, which is dependent upon claim 8, Niemi discloses:

*wherein said user selectively determines the subject matter for comparing.* (col. 7 lines 45-50, discussing determining web page association via “other than conventional keywords”, such as names, dates, tasks or combinations thereof)

**Regarding claim 10**, which is dependent upon claim 1, Niemi discloses:

*wherein an Internet Service Provider performs the intercepting, comparing and re-marking steps.* (col. 3 line 67, stating “This module may be implemented by ... an ISP [sic]”. Note that although “DSP” appears in the referenced passage, the Office believes that this was a typographical error, and “ISP”, which previously appears expanded at col. 3 lines 37-38, was intended.)

**Regarding independent method claim 13**, Niemi discloses:

*A method for automatically converting a first set of information to a second set of information indicative of one or more third sets of information, comprising the steps of:*

*intercepting said first set of information;* (col. 4 lines 10-13, noting “the page is intercepted”)

*comparing said first set of information to a database containing a list of associated second sets of information for a match, said second sets of information being indicative of one or more third sets of information;* (col. 4 lines 21-24, discussing a first word table, and col. 4 lines 53-57 discussing a second table comprising the number of occurrences of each word and a corresponding document/URL)

*modifying said first set of information to include an associated second set of information for each said match;* (col. 5 lines 10-17, noting “added hyperlinks”) and

*displaying said modified first set of information;* (col. 4 lines 13-16, stating “Before forwarding the page to the ... browser for display, the page is modified....”)

*wherein, the selection of said modified first set of information causes the display of said one or more third set of information.* (col. 3 lines 61-62, discussing “Selecting a hyper-link ... causes the browser ... to download a further web page.”)

**Regarding claim 14**, which is dependent upon claim 13, Niemi discloses:

*wherein said information is selected from a group consisting of text data, graphical data, audio data and video data.* (col. 1 lines 45-49, discussing the downloading of an electronic document having keywords [i.e., text data])

**Regarding claim 15**, which is dependent upon claim 13, Niemi discloses:

*wherein:*

*said first set of information includes text in a web page;* (col. 1 lines 45-49, discussing the downloading of an electronic document having keywords [i.e., text data])

*said second set of information includes a hyperlink;* (col. 4 lines 21-24, discussing a first word table, and col. 4 lines 53-57 discussing a second table comprising the number of occurrences of each word and a corresponding document/URL [i.e., a hyperlink]) and

*said third set of information includes a web page addressed by said hyperlink.* (col. 6 lines 41-47, discussing that a user clicks on an added hyperlink to access another web page)

**Regarding claim 16**, which is dependent upon claim 13, Niemi discloses:

*wherein said intercepting, comparing and modifying steps are performed by computer systems selected from the group consisting of a user's system, an Internet Service Provider's system and a content provider's system. .* (col. 3 line 67, stating "This module may be implemented by ... an ISP [sic]". Note that although "DSP" appears in the referenced passage, the Office believes that this was a typographical error, and "ISP", which previously appears expanded at col. 3 lines 37-38, was intended.)

**Regarding independent system claim 23** Niemi discloses:

*A system for automatically converting one or more phrases in a hypertext-enabled document to one or more respective hyperlinks, each of said phrases comprising one or more words, said system comprising:*

*means for intercepting said a hypertext-enabled document prior to being displayed to a user;* (col. 4 lines 10-13, noting "the page is intercepted")

*means for comparing each of said phrases in the a hypertext-enabled document to a database containing a list of words and phrases and associated hyperlink information for a match; (col. 4 lines 21-24, discussing a first word table, and col. 4 lines 53-57 discussing a second table comprising the number of occurrences of each word and a corresponding document/URL)*

*means for re-marking the a hypertext-enabled associated hyperlink information in accordance with each said match; (col. 5 lines 10-17, noting “added hyperlinks”) and*

*document to include means for displaying the re-marked a hypertext-enabled document to said user. (col. 4 lines 13-16, stating “Before forwarding the page to the ... browser for display, the page is modified....”)*

**Regarding independent method claim 24 Niemi discloses:**

*A method for formatting a hypertext-enabled document by automatically converting one or more words or phrases to be included in said hypertext-enabled document to one or more respective hyperlinks comprising the steps of:*

*comparing each of said words or phrases, and morphed variations (col. 4 lines 20-29 discussing a word table that lists word stems [i.e., a morphology database] and a stemming algorithm and col. 4 lines 53-57 discussing the document table, comprised of word occurrences and associated URLs) on said words, to be included in said hypertext-enabled document to a database containing a list of words and associated hyperlink information for a match; (col. 4 lines 21-24, discussing a first word table, and col. 4 lines 53-57 discussing a second table comprising the number of occurrences of each word and a corresponding document/URL)*

*utilizing, in place of said one or more words or phrases, said associated hyperlink information in accordance with each said match in said hypertext-enabled document. (col. 5 lines 10-17, noting “added hyperlinks”)*

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 7, 12 and 26 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Niemi (US Patent No. US 6,415,294, filed Feb 16, 1999, hereafter referred to as "Niemi") in view of Kraemer (US Patent No. US 6,490,602, filed Jan 15, 1999, hereafter referred to as "Kraemer").

**Regarding claim 7**, which is dependent upon claim 1, the limitations of claim 1 have been previously discussed.

Niemi, however, does not explicitly disclose:

*wherein said intercepting, comparing and re-marking steps are preformed by utilizing a user's web browser plug-in functionality.*

Kraemer, though, discloses:

*wherein said intercepting, comparing and re-marking steps are preformed by utilizing a user's web browser plug-in functionality. (col. 3 lines 23-27, discussing "may also be processed by browser")*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Kraemer for the benefit of Niemi, because to do so

would allow a gift buyer to conveniently access and fulfill requested transactions as taught by Kraemer in col. 5 lines 20-25.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Kraemer for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

**Regarding claim 12**, which is dependent upon claim 1, the limitations of claim 1 have been previously discussed.

Niemi, however, does not explicitly disclose:

*wherein said associated hyperlink information is selected from a group consisting of links to purchasing information, technical information, scientific information, news information, stock price information, financial information, copyright information and trademark information.*

Kraemer, though, discloses:

*wherein said associated hyperlink information is selected from a group consisting of links to purchasing information, technical information, scientific information, news information, stock price information, financial information, copyright information and trademark information.* (col. 5 lines 56-67, discussing a modified web page that provides a toolbar with links to such services as “purchasing a product”, and col. 8 lines 5-8 discussing toolbox links to retailers.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Kraemer for the benefit of Niemi, because to do so would allow for increased convenience for a user via automated shopping as taught by Kraemer in col. 7 lines 65-67.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Kraemer for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

**Regarding claim 26**, which is dependent upon claim 24, the limitations of claim 24 have been previously discussed.

Niemi, however, does not explicitly disclose:

*wherein said associated hyperlink information is selected from a group consisting of links to purchasing information, technical information, scientific information, news information, stock price information, financial information, copyright information and trademark information.*

Kraemer, though, discloses:

*wherein said associated hyperlink information is selected from a group consisting of links to purchasing information, technical information, scientific information, news information, stock price information, financial information, copyright information and trademark information.* (col. 5 lines 56-67, discussing a modified web page that provides a toolbar with links to such services as “purchasing a product”, and col. 8 lines 5-8 discussing toolbox links to retailers.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Kraemer for the benefit of Niemi, because to do so would allow for increased convenience for a user via automated shopping as taught by Kraemer in col. 7 lines 65-67.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Kraemer for the benefit Niemi because these

references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

17. **Claim 6 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Niemi (US Patent No. US 6,415,294, filed Feb 16, 1999, hereafter referred to as "Niemi") in view of Kraemer (US Patent No. US 6,490,602, filed Jan 15, 1999, hereafter referred to as "Kraemer") and further in view of Fields et al. (US Patent No. US 6,605,120, filed Dec 10, 1998, hereafter referred to as "Fields").

**Regarding claim 6**, which is dependent upon claim 5, the limitations of claim 5 have been previously discussed.

Niemi, does not explicitly disclose:

*wherein said computer system is a handheld computing device.*

Fields, though, discloses:

*wherein said computer system is a handheld computing device.*  
(col. 11 lines 8-12, discussing "[t]he computers on which the client software ... could reside could be, for example, ... a hand held computer")

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit of Niemi in view of Kraemer, because to do so would allow for a light weight client (user) computer as taught by Fields in col. 11 lines 14-15.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit Niemi in view of Kraemer because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

18. **Claims 11 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niemi (US Patent No. US 6,415,294, filed Feb 16, 1999, hereafter referred to as "Niemi") in view of Ferguson et al. (US Patent No. US 6,490,602, filed Jan 15, 1999, hereafter referred to as "Ferguson").**

**Regarding claim 11,** which is dependent upon claim 1, the limitations of claim 1 have been previously discussed.

Niemi does not explicitly disclose:

*wherein said user selectively activates and deactivates said intercepting, comparing and re-marking steps.*

Ferguson, though, discloses:

*wherein said user selectively activates and deactivates said intercepting, comparing and re-marking steps. (col. 6 lines 36-38, discussing selective activation)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Niemi, because to do so

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would give a user the choice of whether to view online service information and incur a fee as taught by Ferguson in col. 30 lines 27-30.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

**Regarding independent method claim 17 Niemi discloses:**

*A method for generating revenue based on data included in a first set of information to be transmitted in a file to a user connected to a distributed computer network, comprising the steps of:*

*comparing said first set of information in a database of associations of said first set of information to a second set of information; (col. 4 lines 21-24, discussing a first word table [comprised of words from the first set], and col. 4 lines 53-57 discussing a second table comprising the number of occurrences of each word and a corresponding document/URL [second set])*

*modifying said file such that the first set of information references at least one element in the second set of information; (col. 5 lines 10-17, noting "modifies the HTML code" [first set] and "added hyperlinks" [second set])*

*sending said modified file to said user. (col. 4 lines 13-16, stating "Before forwarding the page to the ... browser for display, the page is modified....")*

Niemi, however, does not explicitly disclose:

*charging for the modifications to said file performed in said modifying step;*

Ferguson, though, discloses:

*charging for the modifications to said file performed in said modifying step; (col. 31 lines 13-17, discussing levying fees on content*

providers based on the amount of information [i.e., the number of modifications)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Niemi, because to do so would allow an online service to offer a variable fee structure to a content provider as taught by Ferguson in col. 31 lines 13-15.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

**Regarding claim 18**, which is dependent upon claim 17, the limitations of claim 17 have been previously discussed.

Niemi further discloses:

*wherein said file includes an Internet web page. (col. 4 lines 3-6, "a user requests the downloading of a web page from the WWW")*

**Regarding claim 19**, which is dependent upon claim 17, the limitations of claim 17 have been previously discussed.

Niemi does not explicitly disclose:

*wherein said charging step is directed to a content provider of said first set of information.*

Ferguson, though, discloses:

*wherein said charging step is directed to a content provider of said first set of information.* (col. 31 lines 17-21, discussing levying fees on different classes of content providers)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Niemi, because to do so would allow for an online service to offer a discount pricing plan to certain content providers as taught by Ferguson in col. 31 lines 19-21.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

**Regarding claim 20,** which is dependent upon claim 17, the limitations of claim 17 have been previously discussed.

Niemi does not explicitly disclose:

*wherein said charging step is directed to the content provider of said second set of information.*

Ferguson, though, discloses:

*wherein said charging step is directed to the content provider of said second set of information.* (col. 31 lines 17-21, discussing levying fees on different classes of content providers)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Niemi, because to do so would allow for an online service to offer a discount pricing plan to certain content providers as taught by Ferguson in col. 31 lines 19-21.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

**Regarding claim 21**, which is dependent upon claim 18, the limitations of claim 18 have been previously discussed.

Niemi does not explicitly disclose:

*wherein said step of charging is dependent upon the number of modifications performed in said modifying steps.*

Ferguson, though, discloses:

*wherein said step of charging is dependent upon the number of modifications performed in said modifying steps.* (col. 31, lines 13-17, discussing levying fees on a content provider based upon “the amount or size of information carried on the online service”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Niemi, because to do so would allow an online service to offer a variable fee structure to a content provider as taught by Ferguson in col. 31 lines 13-15.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

**Regarding claim 22**, which is dependent upon claim 17, the limitations of claim 17 have been previously discussed.

Niemi discloses:

*wherein said steps of comparing, (col. 4 lines 21-24, discussing a first word table [comprised of words from the first set], and col. 4 lines 53-57 discussing a second table comprising the number of occurrences of each word and a corresponding document/URL [second set]) modifying (col. 5 lines 10-17, noting “modifies the HTML code” [first set] and “added hyperlinks” [second set])*

Niemi does not explicitly disclose:

*and charging are performed by a computer system selected from the group consisting of a content provider's system, an Internet Service Provider's system and a user's system.*

Ferguson, though, discloses:

*and charging are performed by a computer system selected from the group consisting of a content provider's system, an Internet Service Provider's system and a user's system. (col. 29 lines 35-41, discussing a Fee Setter subtool function used by an online service [ISP] for charging a content provider.)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Niemi, because to do so

would enable an online service to automatically levy fees as taught by Ferguson in col. 29 lines 41-44.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

19. **Claims 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niemi (US Patent No. US 6,415,294, filed Feb 16, 1999, hereafter referred to as "Niemi") in view of Fields et al. (US Patent No. US 6,605,120, filed Dec 10, 1998, hereafter referred to as "Fields").**

**Regarding claim 25,** which is dependent upon claim 24, the limitations of claim 24 have been previously discussed.

Niemi, however, does not explicitly disclose:

*wherein said comparing and utilizing steps are performed by a content provider.*

Fields, though, discloses:

*wherein said comparing and utilizing steps are performed by a content provider. (col. 3 lines 2-4, discussing "The recast web page may be produced by ... a web content provider.")*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit of Niemi, because to do so would enable a potential increase in ad revenues as taught by Fields in col. 4 lines 51-54.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

**Regarding independent method claim 27 Niemi discloses:**

*A method for automatically modifying one or more phrases in an electronic document to one or more respective related phrases comprising the steps of :  
intercepting said electronic document prior to being displayed to a user; (col. 4 lines 10-13, noting “the page is intercepted”)  
comparing each of said phrases in the electronic document to a database containing a list of phrases*

Niemi, however, does not explicitly disclose:

*and associated modifying phrases for a match;*

Fields, though, discloses:

*and associated modifying phrases for a match; (col. 9 lines 9-16, discussing injection of content, titles, copyright statements and logos)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit of Niemi, because to do so

would allow for the creation of a dynamic publishing template as taught by Fields in col. 9 lines 11-14.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit Niemi because these references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

Niemi further discloses:

*re-marking the electronic document to include ... in accordance with each said match;*

However, Niemi does not explicitly disclose:

*the associated phrase*

Fields, though, discloses:

*the associated phrase (col. 9 lines 9-16, discussing injection of content, titles, copyright statements and logos)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit of Niemi, because to do so would allow for the creation of a dynamic publishing template as taught by Fields in col. 9 lines 11-14.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit Niemi because these

references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

Niemi further discloses:

*displaying the re-marked electronic document to said user.* (col. 4 lines 13-16, stating "Before forwarding the page to the ... browser for display, the page is modified....")

**Regarding claim 28**, which is dependent upon claim 27, the limitations of claim 27 have been previously discussed.

Niemi, however, does not explicitly disclose:

*wherein the one or more phrases each include one or more words.*

Fields, though, discloses:

*wherein the one or more phrases each include one or more words.* (col. 9 lines 9-16, discussing injection of content, titles, copyright statements and logos)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit of Niemi, because to do so would allow for the creation of a dynamic publishing template as taught by Fields in col. 9 lines 11-14.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Fields for the benefit Niemi because these

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references were all applicable to the same field of endeavor, i.e., the manipulation of web-based content.

### Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Non-patent Literature***

Blustein, James, "Automatically Generated Hypertext Versions of Scholarly Articles and their Evaluation", Proceedings of the Eleventh ACM Conference on Hypertext and Hypermedia, San Antonio, May 2000, pp. 201-210 (plus article citation sheet), [ACM 1-581 13-227-1/00/0006].

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Jones, Steve, et al., "Topic-Based Browsing Within a Digital Library Using Keyphrases", Proceedings of the Fourth Conference on Digital Libraries, San Antonio, Aug. 1999, pp. 114-121 (plus article citation sheet).

Kellogg, Robert B., et al., "Text to Hypertext: Can Clustering Solve the Problem in Digital Libraries?", Proceedings of the First ACM International Conference on Digital Libraries, Bethesda, MD, Apr. 1996, pp. 144-150 (plus article citation sheet), [ACM 0-89791-830-4/96/03].

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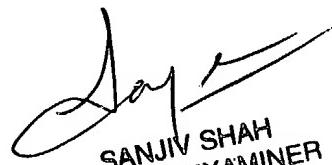
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M Stevens whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Stevens  
Art Unit 2176  
Date: August 4, 2004

rms



SANJIV SHAH  
PRIMARY EXAMINER

A handwritten signature of "Sanjiv Shah" is written in black ink. Below the signature, the words "PRIMARY EXAMINER" are printed in a smaller, sans-serif font.